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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,738	04/20/2000	Ingemar H. Lundquist	A-59616-4/HCH/ENB	5549

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EXAMINER

THOMPSON, MICHAEL M

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 03/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/553,738

Applicant(s)

LUNDQUIST ET AL.

Examiner

Michael M. Thompson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 14-18, and 23-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Orandi, U.S. Patent No. 4,524,770. Orandi teaches a treatment device assembly for an endoscopic surgical instrument comprising a hollow needle/electrode, a control mechanism means for extending and retracting the needle/electrode (12), a means for interlocking said assembly to a housing, the cannula (64) including a curvable surface (see the tip of the cannula) for deflecting the needle at an angle from the primary axis, having a wire, first and second ends, means for tensioning said wire, means for deflecting in a curved end, generator for supplying radio frequency energy, and a fiber optic disposed in the axial lumen of a needle.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 19-22, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orandi in view of LeVeen U.S. Patent No. 3,991,770. Orandi teaches all of the limitations of the claims except for explicitly stating an electrode utilizing radio frequency ablation. LeVeen teaches an electrode ablative device that utilizes a radio frequency ablative power source to ablate tissue. It would have been obvious to one of ordinary skill in the art to utilize the electrode device of Orandi with an radio frequency ablative power source for ablation since radio frequency ablative devices are well known in the prior art in combination with electrode devices for a myriad of treatments to include treating tumors.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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7. Claims 14-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all claims in U.S. Patent No's. 6,102,886; 5,848,986; 5,531,677; 5,409,453. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No's. supra are highly similar to the instant application in that both clearly teach a treatment device assembly for an endoscopic surgical instrument comprising a needle, a means for guiding the needle, a control structure means for extending and retracting the needle, a means for interlocking said assembly to a housing, a means for deflecting the needle at an angle from the primary axis, a means for guiding having a bendable sheath, having a wire, first and second ends, means for tensioning said wire, means for deflecting in a curved end, means for supplying radio frequency energy, and a laser fiber optic disposed in the axial lumen of a needle.

#### *Response to Arguments*

6. Applicant's arguments filed 01-30-2002 have been fully considered but they are not persuasive. It is unclear to the Examiner what Applicant's argument is with respect to Claim 14 in paragraph 3 on page 6 by stating, "Contrary to the assertion of the Examiner, Orandi does not disclose an assembly as called for in Claim 14 having a cannula for slidable receiving a needle so as to guide said needle. As noted above, needle 12 of the Orandi device is disposed directly with sheath 78 and not within a cannula which is disposed in the sheath 78." Most notably it is the last sentence of this argument that is confusing. It states that the Orandi device is disposed directly within sheath 78 and not a needle within a cannula that is within a sheath. It appears that Applicant is arguing limitations that are not within the claims.

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With respect to claim 24 Applicant states that, "Orandi does not disclose a guide cannula mounted in a passageway of an elongate probe member. The Examiner respectfully disagrees with Applicant's statement. It is the Examiner's position that the guide cannula (78) is mounted in a passageway of the elongated probe member/housing (88). It is the Examiner's position that the prior art rejection is still applicable and that all of Applicant's arguments have been addressed.

### Contacts

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Michael Thompson whose telephone number is (703) 305-1619. The Examiner can normally be reached on Monday through Friday from 9 am to 5 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Primary, AnhTuan Nguyen, can be reached on (703) 308-2154. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4520.

Michael M. Thompson

Patent Examiner

MT

*MAR 8*  
February 28, 2002

*ANHTUAN T. NGUYEN*  
PRIMARY EXAMINER  
*12/2/02*